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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,137	01/27/2000	Takayuki Watanabe		9482

7590 05/10/2005

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EXAMINER

MADSEN, ROBERT A

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/492,137

Applicant(s)

WATANABE ET AL.

Examiner

Robert Madsen

Art Unit

1761

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 3/7/2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-4,6,8,10 and 12.

Claim(s) withdrawn from consideration: 13.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

ADVISORY ACTION

1. The Response to the Advisory Action (mailed February 23, 2005) filed March 7, 2005 been entered.
2. The Examiner has re-considered the Declaration under 37 CFR 1.132 filed June 7, 2004, in light of the submitted data tables comparing the composition after drying in the Response filed March 7, 2005. The Declaration filed June 7, 2004 presented data comparing the stability of the inventive composition to the stability of the *individual* reference compositions relied on in rejections based on a combination of references made under 35 U.S.C. 103 (a). However, the Declaration disclosed the "emulsion composition" and failed to indicate the dry powder composition, as recited in the pending claims. The Response filed March 7, 2005 shows the powder composition of the individual references and the two inventive powder composition discussed in the Declaration: (1) 38.8% trehalose, 38.8% hemicellulose, and Lemon oil and (2) 38.1% trehalose and 38.1% hemicellulose with Paprika oil. These compositions fall within the range recited in Claims 1-4, 8, 10 and 12, but are not within the range recited in claim 6. An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter as stated in both 716.02 (e) and 716.02 (d).
3. Applicant concludes that the Declaration, in light of the powder compositions presented in the Response, is sufficient to overcome the prima facie case of obviousness based on the combination of references established in the Office Action mailed March 5, 2004 because it shows the inventive composition has a superiority in stability to each individual reference (note the rejections made in the Office Action mailed March 5, 2004 and the arguments made in the

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Office Action mailed January 30, 2004). Applicant relies on MPEP 716.02 (a), section II, namely *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987) and *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990), to support this conclusion.

4. The Examiner maintains that the Declaration is insufficient to overcome the rejections of record because the facts considered in the cases cited in MPEP 716.02 (a), section II are not identical to the facts of the present application. For example, the facts of *In re Chupp* are concerned with an herbicidal composition containing a single compound, the closest prior art compound differed by a single methylene group (-CH₂-), and the method claims to the use of the compound as in an herbicidal composition were already allowed. The facts of *Ex parte A* are directed to claims reciting chemical compounds as "an antibacterial composition", the closest reference disclosure was generic to the claimed subject matter, with one species differing from the claimed compound by an 8-fluoro substituent in place of another substituent. The examiner maintained it was necessary for the claimed compound to be unexpectedly different from the reference compounds "overall," i.e., in its therapeutic effect against all bacteria. The appellants' thesis is that their compound is unexpectedly and significantly superior against anaerobic bacteria, a property which makes it unexpectedly suited for a specific, important utility.

5. The facts of the present application relate to a combination of two references to arrive at a specified composition. In one rejection, for example, the primary reference teaches a cocoa powder with soybean protein and 1-6% pullan or hemicellulose, and the secondary reference teaches that soybean protein flavor is very pronounced and one must add at least 5% and up to 40% trehalose to mask the soybean protein flavor in a cocoa powder. In the other rejection, the


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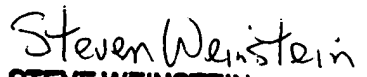
primary reference teaches cosmetic powder that is a non-sticky, stable cosmetic that maintains moisture and comprises trehalose up to 50% , perfume and a water soluble polymer, and the secondary reference teaches in order for a cosmetic to retain moisture for an extended shelf life add hemicellulose at a level of 0.001-20% because conventional water soluble polymers have faults. See the Office Action mailed March 5, 2004. The secondary references relied on in both rejections lead one of ordinary skill art to make the specific substitution or combination. Thus, the combination of references unequivocally teaches applicant's claimed composition for specific advantages.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (571) 272-1402. The examiner can normally be reached on 7:00AM-3:30PM M-F.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Madsen 
Examiner
Art Unit 1761


STEVE WEINSTEIN
PRIMARY EXAMINER 1761